

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD L. SMITH

Appeal No. 2001-1863
Application No. 08/603,665

ON BRIEF

Before FLEMING, RUGGIERO, and LALL, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-21, which constitute all the pending claims in the application.

The disclosed invention is directed to an interface module

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The connections do not require any leads and the interface module is easily removable from the portable telephone as well as from the computer. The invention is adequately described at pages 2 and 3 of the brief and also is well illustrated in Fig. 7, Fig. 10, and Fig. 13 of the disclosure. The following claim further illustrates the invention.

1. A telecommunications apparatus, comprising:

a portable telephone having an interface; and

an interface module removably connected to said portable telephone along one and only one surface of said portable telephone, said interface module having a first interface directly connected to said portable telephone interface; and a second interface, coupled to said first interface, said second interface facilitating a direct physical and electrical connection to a computer interface.

The Examiner relies on the following references:

Morris	5,020,090	May 28, 1991
Braitberg et al. (Braitberg)	5,333,177	July 26, 1994
O'Sullivan	5,353,334	Oct. 4, 1994
Gulick et al. (Gulick)	5,555,287	Sep. 10, 1996
		(filed Jul. 21, 1992)
Mizoguchi et al. (Mizoguchi)	5,566,226	Oct. 15, 1996
		(filed May 26, 1995)

Claims 1-12 and 21 stand rejected under 35 U.S.C. § 103(a)

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Claims 13 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizoguchi in view of Morris and O'Sullivan.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizoguchi in view of Morris, O'Sullivan and Braitberg.

Claim 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizoguchi in view of Morris, O'Sullivan and Gulick.

Rather than repeat the arguments of Appellant and the Examiner, we make reference to the brief (paper no. 12), reply brief (paper no. 16), the final rejection (paper no. 9) and the answer (paper no. 13) for the respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellant's arguments set forth in the briefs.

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Mizoguchi and Morris is central to all the combinations rejecting the claims on appeal. Therefore, we analyze the rejection of claim 1 which is based on Mizoguchi and Morris, and which constitutes the basic grounds for the rejections of all the claims on appeal.

REJECTION UNDER 35 U.S.C. § 103

As a general proposition, in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Following the above guidelines, the Examiner sets forth in

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of providing a removable interface/mounting bracket which allows phone manufactured by different companies . . . to be removably connected to a computer" Appellant argues (brief at page 15, and reply brief at page 4) that the Examiner has used improper hindsight and that there is no suggestion or motivation in the references to make the combination.

However, we agree with the Examiner that Morris discloses (Figs. 1 and 7) that an adaptor such as 10 enables the use of cellular portable telephones manufactured by different telephone companies for removably connecting these phones to an external apparatus such as a computer. See column 4, lines 13-27.

Appellant further argues (brief at pages 13 and 14, and reply brief at page 4) that even if the combination of Mizoguchi and Morris were proper, the combination will still not meet the limitation, "an interface module removably connected to said portable telephone **and contacting one and only one surface of said portable telephone**" (id. at page 13). Appellant at page 13 of the brief explains how, in Fig. 7 of Morris, which is used by the

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In response to Appellant's assertion that the portable telephone in Morris makes contacts with the adaptor at five different surfaces, the Examiner advances a new theory at pages 5 and 6 of the Examiner's answer. The Examiner points to Fig. 1 of Morris and asserts (id. at page 5) that "[t]he mounting bracket 58 also has an electrical interface (48, 50; as shown in Fig. 1) which is configured to interface and connect with the electrical connectors of the track (12) of the computer." However, we do not agree with the Examiner's interpretation of Fig. 1 of Morris. Element 10 in Fig. 1 enables the telephone 38 to be removably connected to the computer 22, therefore, element 10 would correspond to element 62 in Fig. 7 which the Examiner had used in the final rejection. However, if we consider 10 as the interconnecting module this module is not removably connected to the computer as recited in claim 1.

The Federal Circuit in In re Lee, 277 F.3d 1338, 1344-1345, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) emphasized the need for an informed decision by the agency based upon evidence in the record.

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Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting Burlington Truck Lines v. United States, 371 U.S. 156, 168 (1962)); Securities & Exchange Comm'n v. Chenery Corp., 318 U.S. 80, 94 (1943) ("The orderly function of the process of review requires that the grounds upon which the administrative agency acted are clearly disclosed and adequately sustained.").

The foundation of the principle of judicial deference to the rulings of agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency's application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See Baltimore and Ohio R. R. Co. v. Aberdeen & Rockfish R. R. Co., 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would become lost "in the haze of so-called expertise"). . . . The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability.

Clearly, Lee reiterates that a reasoned conclusion by the examiner must be supported by some evidence in the administrative record.

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one and only one surface of said portable telephone. In fact, element 10 in Fig. 1 is fixed.

Furthermore, only bracket 58 (Fig. 9) appears to meet the recited limitation of removably connected to the portable telephone, however, as pointed out by Appellant at page 13 of the brief, it does not meet the recited limitation of contacting one and only one surface of said portable telephone. The Examiner's switch to Fig. 1 of Morris satisfies the requirement of contacting only one and one surface of said portable telephone, however, does not meet the recited limitation of removably connected to the telephone.

Thus, applying the precepts annunciated in Lee, we do not find that the Examiner has made adequate findings to support the rejection.

Therefore, we do not sustain the rejection of any of the claims on appeal since Mizoguchi and Morris are relied upon by the Examiner to meet the limitations recited in claim 1 and other independent claims, 13, 19 and 21. The other references, namely

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The decision of the Examiner rejecting claims 1-21 under
35 U.S.C. § 103(a) is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PARSHOTAM S. LALL)	
Administrative Patent Judge)	

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